

REMARKS

This is intended as a full and complete response to the Office Action dated April 29, 2005, having a shortened statutory period for response set to expire on July 29, 2005.

Claims 1-24, 50-55, 57, 60, 61 and 70-93 remain pending in the application and are shown above. Reconsideration of the rejected claims is requested for reasons presented below.

New Figure 6 is submitted herewith to overcome the Examiner's drawing objection. Figure 6 shows the apparatus disposed on a drilling tower. The specification has been amended to include a description of Figure 6. No new matter has been added.

35 U.S.C. § 112

Claims 50-55, 61, 70-75, 77, and 83-92, stand rejected under 35 USC § 112, first paragraph. The Examiner states that the recitation of the apparatus being secured to a "drilling tower" is not supported in the specification.

Applicant respectfully traverses this rejection. Paragraph [0009] of the specification specifically provides as follows:

[0009] Preferably, said mounting assembly comprises a bearer which can be clamped to a structural member in a drilling tower, a carriage pivotally mounted on said bearer and a clamp assembly for securing said piston and cylinder assembly to said mounting assembly.

(emphasis added). Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103

Claims 1-24, 60, 74 and 75, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kelly*, U.S. Patent No. 3,881,375 in view of *Swoboda*, U.S. Patent No. 3,840,128. The Examiner states that *Kelly* discloses the mounting assembly is

IN THE DRAWINGS:

The attached sheets of replacement drawings include new Figure 6, which shows the apparatus mounted on a drilling tower.

Attachment: Replacement Sheets

coupled to a support member on a drilling rig because *Kelly* involves a drilling operation in which the support member must inevitably be connected to some part of the drilling rig.

Kelly discloses an apparatus having a tong assembly T supported on a vertical column having a base support. (See, Figure 1; column 2, Ins. 47-64). *Swoboda* discloses a racking arm having a pipe gripping head. The racking arm is positioned on the platform 10 between the rotary table 12 and the derrick leg bedplate 30. (See, column 4, Ins. 15-17, 24-26). The references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly is coupled to a support member on a drilling tower, as recited in claim 1 and claims depending therefrom. Withdrawal of the rejection is respectfully requested.

Claims 50-55, 57, 61, 70-73 and 76-92, stand rejected under 35 USC § 103(a), as being unpatentable over *McArthur*, U.S. Patent No. 4,652,195 in view of *Kelly*. The Examiner states *McArthur* discloses all of the limitations of the claims except for the tool being a tong capable of making up or breaking out tubulars. The Examiner also states *Kelly* discloses a movable wellbore tool that is a tong capable of making up or breaking out tubulars. The Examiner further states that it would have been obvious to modify the apparatus of *McArthur* with the tong of *Kelly* in order to have eliminated the need for an operator to perform the separate step of making up or breaking out the tubulars once they are put into position.

Applicant respectfully traverses this rejection. The Federal Circuit recently reemphasized that the U.S. Patent and Trademark Office bears the burden of establishing a case of *prima facie* obviousness. *In Re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999). *In Re Dembicza*k requires the Examiner to *particularly* identify any suggestion, teaching or motivation from within the references to combine the references.

Kelly discloses an apparatus having a tong assembly T supported on a vertical column having a base support. The tong assembly engages the pipes after the pipe sections have already been stabbed into each other. *Kelly* does not disclose positioning

the tong assembly on a derrick. *McArthur* discloses a casing stabbing apparatus assembly positioned on a derrick for engaging a median portion of a suspended casing, and thereafter swing or move the casing to more precisely align the casing over another casing. The stabbing apparatus cannot make up or break out the casings. In fact, the casings are made up in a separate step. (Col. 6, Ins. 52-59). Referring to Figure 1, an operator is shown standing on the rig floor using a wrenching apparatus to make up the casings. Thus, *McArthur* actually teaches away from the combination because it teaches using a wrenching apparatus to make up the tubular instead of the stabbing apparatus. Therefore, no motivation or suggestion exists to combine the references. Thus, the Examiner has merely used hindsight based on the Applicant's disclosure to piece together various prior art in order to render the Applicant's claimed invention obvious.

The references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly is coupled to a support member on a drilling tower, as recited in claim 1.

Also, the references, neither alone nor in combination, teach, show, or suggest an extendable structure having a variable length and the tong capable of making up or breaking out tubulars attached to one end of the extendable structure and a support beam for coupling the extendable structure to a drilling tower, as recited in claim 50.

Further, the references, neither alone nor in combination, teach, show, or suggest providing an apparatus for connecting the tubulars, the apparatus comprising a tong adapted to connect the tubulars and an extendable structure for positioning the tong; and positioning the apparatus on a drilling tower, as recited in claim 70.

Further, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly is adapted to couple the extendable structure to a support beam disposed above a rig floor, as recited in claim 76. Further, the references, neither alone nor in combination, teach, show, or suggest the support beam is selectively attached to a drilling tower, as recited in claim 77. Further still, the

references, neither alone nor in combination, teach, show, or suggest the support beam is located between 2 meters and 3 meters above the rig floor, as recited in claim 80.

Further, the references, neither alone nor in combination, teach, show, or suggest attaching the tong to the extendable structure and positioning the extendable structure on a drilling tower, as recited in claim 83.

Further, the references, neither alone nor in combination, teach, show, or suggest the mounting assembly is coupled to the support beam such that the extendable structure can position the tong proximate a connection of the tubulars, as recited in new claim 93.

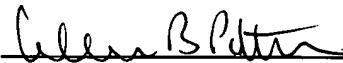
Withdrawal of the rejection is respectfully requested.

Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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